

REMARKS

By this Amendment, Applicant amends claims 1-2, 4-6, 11, 13-14, 16-18 and 20.

Claims 1-20 remain pending and under current examination.

In the Office Action,¹ the Examiner took the following actions:

(a) rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite;

(b) rejected claims 1, 3, 8-9, 13, 15, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki (JP Patent Application Publication 09-190306) ("Mochizuki");

(c) rejected claims 2, 4-6, 14, 16, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki in view of Kondo et al. (JP Patent Application Publication 10-098605) ("Kondo"); and

(d) rejected claims 7 and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki in view of Yamaguchi et al. (US Patent Application Publication 2002/0101443) ("Yamaguchi").

Applicant requests reconsideration and withdrawal of the rejections for the following reasons.

Rejection of Claim 1 under 35 U.S.C. § 112 second paragraph:

The Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner alleges that

[t]he [phrase] "and to control the transmission unit to interrupt the first transmission and to start the second transmission when the transmission unit completes transmitting the data having the first identification information corresponding to the second identification information of the command" in claim 1 is conflicting. If the transmission unit completes transmitting the data, then there would be no interruption on the first transmission." (Office Action, page 2.)

In response, Applicant has amended claim 1. Claim 1 now recites, in part, "and to control the transmission unit to interrupt *a third transmission of data having the first identification information which does not correspond to the second identification*

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

information of the command and to start the second transmission if the transmission unit has completed transmitting the data having the first identification information corresponding to the second identification information of the command” (emphasis added). The “data” recited in “a third transmission of *data* having the first identification information which does not correspond to the second identification information of the command” differs from the “data” recited in “the transmission unit has completed transmitting the *data* having the first identification information *corresponding* to the second identification information of the command,” emphasis added. Thus there would be interruption of the third transmission if the transmission unit has completed transmitting the data. Applicant therefore submits that amended claim 1 fully complies with the requirements of §112, second paragraph, and requests withdrawal of the rejection.

Rejection of claims 1, 3, 8-9, 13, 15, 17 and 19 under 35 U.S.C. § 103(a):

A *prima facie* case of obviousness has not been established. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

Regarding claim 1, at least one requirement for establishing a *prima facie* case of obviousness is not met, because Mochizuki does not teach or suggest every feature of Applicant’s claim. For example, Mochizuki does not teach or suggest at least anything related to Applicant’s “command *having second identification information for identifying data corresponding to the command*,” “a second control unit configured ... to control the transmission unit not to start the second transmission *if the transmission unit is transmitting the data having the first identification information corresponding to the second identification information of the command*,” and “to control the transmission unit to *interrupt a third transmission of data having the first identification information which does not correspond to the second identification information of the command*... if the transmission unit has completed transmitting the data having the first identification information corresponding to the second identification information of the command,” as recited in amended claim 1 (emphasis added).

The Examiner alleges Mochizuki discloses that “the control command is sent to the printer in preference to the image data (abstract: solution), which would have been obvious to one of ordinary skill in the art to recognize that the command have the identification for identifying the data corresponding to the command, so that the transmission unit and printer can recognize what data the command refers to.” (Office Action page 3.) Applicant disagrees.

Mochizuki states that “it is the information processor in which control image formation equipment and an image is made to form, and is characterized by having an interface means to interface with said image formation equipment, and the interface

control means which gives priority over image data to *the control command which controls said image formation equipment, and is supplied to said interface means.*"

Machine translation of Mochizuki, [Means for Solving the Problem], emphasis added.

Therefore, the control command in Mochizuki controls the image formation equipment *directly*, and thus does not constitute the claimed "command *having second identification information for identifying data corresponding to the command,*" as recited in claim 1, emphasis added. In fact, Mochizuki is silent on teaching any corresponding relationship between the image and the command.

Therefore, in contrast to the claimed invention, while Mochizuki discloses "the control command is sent to the printer 160 in preference to the image data" (Abstract [SOLUTION]), Mochizuki cannot determine "if the transmission unit is transmitting *the data having the first identification information corresponding to the second identification information of the command,*" and "if the transmission unit has completed transmitting *the data having the first identification information corresponding to the second identification information of the command,*" at least because Mochizuki fails to teach a corresponding relationship between the image and the control command. Mochizuki also cannot "interrupt a third transmission of *data having the first identification information which does not correspond to the second identification information of the command,*" at least because Mochizuki fails to teach a corresponding relationship between the image and the control command.

Further, Mochizuki teaches "the 1st mode which...supplies said control command to said interface means through said spooler, and...the 2nd mode which supplies said control command to said interface means," and "to choose said 1st or 2nd mode based on directions of a user." Machine translation of Mochizuki, paragraphs [0011]-[0012],

emphasis added. Therefore, Mochizuki merely teaches transmitting the control command directly or through a spooler, *according to the user's decision*. Thus, in contrast to Applicant's claim 1, in Mochizuki, a determination of whether to transmit the control command does not relate to conditions of transmission of the image.

Therefore, while Mochizuki discloses that the user can choose the 1st mode or the 2nd mode (paragraphs [0011]-[0012]), nowhere in Mochizuki is there any disclosure or suggestion of the claimed "a second control unit configured ... to control the transmission unit not to start the second transmission *if the transmission unit is transmitting the data having the first identification information corresponding to the second identification information of the command,*" and "to control the transmission unit to interrupt a third transmission of data having the first identification information which does not correspond to the second identification information of the command...*if the transmission unit has completed transmitting the data having the first identification information corresponding to the second identification information of the command,*" as required in amended claim 1 (emphasis added).

Moreover, the Examiner alleges Mochizuki teaches that

not only higher transmission priority is given to command transmission unit over data in transmission unit (150 of Fig. 2), but control section also sends command to hold data in spooler [field] (paragraph 0043) at the same time. Thus, input of second transmission of command transmission interrupts first transmission of data transmission (paragraph 0038). (Office Action page 4.)

Mochizuki states that its alleged invention "is characterized by transmitting said control command preferentially in the 1st mode, and transmitting said control command and said image data *in order of those acquisition* in the 2nd mode," Mochizuki, paragraph [0017], emphasis added. Mochizuki further discloses that the control command is transmitted to a printer *subsequently* to the image data held in the spooler

field in the 2nd mode. Mochizuki, paragraph [0043]. Therefore, in Mochizuki's 2nd mode, the control command and the image data are transmitted *in order of their acquisition*, and thus the control command is not given priority over the image data. Therefore, control section (112b of Fig. 2) in Mochizuki does not "interrupt a third transmission of data having the first identification information which does not correspond to the second identification information of the command," as required by amended claim 1.

In summary, a *prima facie* case of obviousness of claim 1 over Mochizuki has not been established. Accordingly, Applicant requests that the 35 U.S.C. § 103(a) rejection of claim 1 be withdrawn.

Rejection of claims 13 and 17 under 35 U.S.C. § 103(a):

While amended independent claims 13 and 17 are of different scope than claim 1, they recite limitations corresponding to those of claim 1 discussed above. Therefore, amended independent claims 13 and 17 are also allowable over Mochizuki for at least the reasons set forth above regarding claim 1.

Rejection of claims 3, 8, 9, 15 and 19 under 35 U.S.C. § 103(a):

Dependent claims 3, 8, 9, 15, and 19 are also allowable over Mochizuki at least due to their dependence from one of claims 1, 13 or 17.

Rejection of claims 2, 4-6, 14, 16, 18 and 20 under 35 U.S.C. § 103(a):

Kondo discloses that "[t]he FAX server 202 receives the facsimile Request to Send and print request from an information processing terminal (this example terminal unit 204) on LAN, and controls a remote control etc. to said facsimile apparatus 201 connected." Machine translation of Kondo, paragraph [0019].

The Examiner alleges that “Kondo et al. teach further comprising a third control unit configured to control the transmission unit to resume the first transmission interrupted by the second control unit, the first transmission interrupted being restarted after the command has been transmitted. (Fig. 4, paragraphs 0033-0034).” (Office Action, page 6.) While Applicant does not accede to the Examiner’s position, Kondo nevertheless fails to teach or suggest at least the above listed claim elements recited in claim 1 as well as corresponding limitations of claims 13 and 17. Therefore, dependent claims 2, 4-6, 14, 16, 18, and 20 are also allowable over Mochizuki in view of Kondo for at least the reasons set forth above regarding claims 1, 13 and 17.

Rejection of claims 7 and 10-12 under 35 U.S.C. § 103(a):

Yamaguchi appears to disclose that an image display apparatus 100 has an communication unit 101 which has a network interface unit 111 and a data transmission/reception unit 112. Yamaguchi, paragraph [0023].

The Examiner alleges that “Yamaguchi et al. teaches the transmission unit utilizes a radio communication technique called Bluetooth (paragraph 0024).” (Office Action, page 8.) While Applicant does not accede to the Examiner’s position, Yamaguchi nevertheless fails to teach or suggest at least the above listed claim elements recited in claim 1. Therefore, dependent claims 7 and 10-12 are allowable over Mochizuki in view of Yamaguchi for at least the reason set forth above regarding claim 1.

Conclusion

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejections. Pending claims 1-20 are in condition for allowance. Accordingly, Applicant requests a favorable action.

If there are any remaining issues or questions, Applicant requests the Examiner telephone the undersigned representative to discuss them.

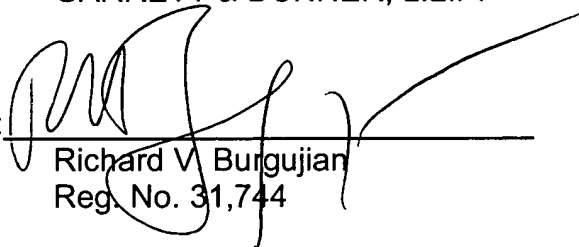
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 13, 2006

By:


Richard V. Burgujian
Reg. No. 31,744